

REMARKS:

Claims 2-11, 13-21, and 23-31 are currently pending in the application.

Claims 1, 12, and 22 have been previously canceled without prejudice.

Claims 2, 13, and 23 stand objected to for certain informalities.

Claims 2-11, 13-21, and 23-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,587,969 B1 to Weinberg et al. ("*Weinberg*") in view of U.S. Patent No. 6,532,023 to Schumacher et al. ("*Schumacher*").

By this Amendment, Claims 2, 13, and 23 have been amended to correct certain typographical errors. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

CLAIM OBJECTIONS:

Claims 1, 13, and 23 stand objected to for certain informalities. Specifically, the Examiner states that the word "users" in Claims 1, 13, and 23 should be replaced with "user's". (19 December 2006 Office Action, Page 2).

The Applicants initially note that independent Claim 1 has been previously canceled without prejudice; however, independent Claim 2 includes the word "users". Therefore, the Applicants are treating the objection to Claims 1, 13, and 23, as an objection to Claims 2, 13, and 23. The Applicants respectfully request the Examiner to correct the Applicants if this is an incorrect assumption.

In response to the Examiner's objection, the Applicants have amended Claims 2, 13, and 23 to recite the word "user's" instead of "users". The amendment to Claims 2, 13,

and 23 are merely typographical corrections and are not necessitated by any prior art and are unrelated to the patentability of the present invention.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2-11, 13-21, and 23-31 stand rejected under 35 U.S.C. § 103(a) over *Weinberg* in view of Schumacher.

The Applicants respectfully submit that *Weinberg* or Schumacher, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 2-11, 13-21, and 23-31. Thus, the Applicants respectfully traverse the Examiners obvious rejection of Claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 103(a) over the proposed combination of *Weinberg* or Schumacher either individually or in combination.

The Proposed *Weinberg-Schumacher* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent Claim 2, this claim recites:

A computer-implemented method for reproducing a selection of members in a hierarchy, the method performed using a computer system comprising one or more processing units and one or more memory units, the method comprising:

providing a member selection interface to a user, the member selection interface ***capable of providing the user with the ability to navigate through a hierarchy of members***;

receiving input of the user from the member selection interface;

determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from the hierarchy of members, ***the hierarchy of members being associated with a particular dimension of an organization of data***;

recording the sequence of actions of the user in a member selection script, the member selection script ***including a hierarchy selection command for determining the sequence of actions to be recorded***; and

executing the recorded member selection script, ***after the hierarchy of members has been modified, to reproduce the user's original input to the member selection interface***, based upon the members and ***hierarchical relationships of the user's original inputs*** from the member selection interface. (Emphasis Added).

Independent Claims 13 and 23 recite similar limitations. *Weinberg* and *Schumacher*, either individually or in combination, fail to disclose each and every limitation of independent Claims 2, 13, and 23.

The Applicants respectfully submit that *Weinberg* fails to disclose, teach, or suggest independent Claim 2 limitations regarding a ***“computer-implemented method for reproducing a selection of members in a hierarchy”*** and in particular *Weinberg* fails to disclose, teach, or suggest independent Claim 2 limitations regarding ***“providing a member selection interface to a user***, the member selection interface ***capable of providing the user with the ability to navigate through a hierarchy of members”***. In particular, the Examiner equates ***“providing a member selection interface to a user”*** recited in independent Claim 2, with “displaying the test as a tree” disclosed in *Weinberg*. (19 December 2006 Office Action, Page 3). However, “displaying the test as a tree” disclosed in *Weinberg* merely represent steps of the test, and ***does not include, involve, or even relate to providing a member selection interface to a user***, as recited in independent Claim 2. (Abstract). In contrast, the present invention provides a ***“member selection interface to a user”*** wherein the “member selection interface [is] ***capable of providing the user with the ability to navigate through a hierarchy of members”***. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Weinberg* and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from *Weinberg*.

The Applicants further respectfully submit that *Weinberg* fails to disclose, teach, or suggest independent Claim 2 limitations regarding ***“receiving input of the user from the member selection interface”***. In particular, the Examiner equates ***“receiving input of the user from the member selection interface”*** recited in independent Claim 2 with “the

user interface” disclosed in *Weinberg*. (19 December 2006 Office Action, Page 3). However, ***the user interface disclosed in Weinberg*** is merely a user interface of a testing tool that allows the user to define verification steps to automatically test for expected server responses during test execution, and ***does not include, involve, or even relate to a member selection interface, as recited in independent Claim 2.*** (Abstract). In contrast, and as discussed above, the “***member selection interface***” recited in independent Claim 2 ***provides a user with the ability to navigate through a hierarchy of members and select particular members the user desires for a particular function.***

The Applicants still further respectfully submit that *Weinberg* fails to disclose, teach, or suggest independent Claim 2 limitations regarding “***determining a sequence of one or more actions associated*** with a member selection tree, the actions collectively selecting one or more members from the hierarchy of members, ***the hierarchy of members being associated with a particular dimension of an organization of data***”. In particular, the Examiner equates “***the hierarchy of members being associated with a particular dimension of an organization of data***” recited in independent Claim 2 with the server screen disclosed in *Weinberg*. (19 December 2006 Office Action, Page 3). However, the server screen ***disclosed in Weinberg*** is merely a separate window that is displayed to the user and ***has nothing to do with a particular dimension of an organization of data***, as recited in independent Claim 2. (Column 3, Lines 11-36). In contrast, “***the hierarchy of members being associated with a particular dimension of an organization of data***” recited in independent Claim 2 allows a user to select a particular data dimension from which members are to be selected and may include, but is not limited to, a product dimension, a geography dimension, and a time dimension. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Weinberg* and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from *Weinberg*.

The Office Action Acknowledges that *Weinberg* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Weinberg* fails to disclose the emphasized limitations noted above in independent Claim 2. Specifically the Examiner acknowledges that *Weinberg* fails to teach “recording the sequence of actions of the user in a member selection script, the member selection script including a hierarchy selection command for determining the sequence of actions to be recorded; and executing the recorded member selection script, after the hierarchy of members has been modified, to reproduce the user’s original input to the member selection interface, based upon the members and hierarchical relationships of the user’s original inputs from the member selection interface”. (19 December 2006 Office Action, Page 4). However, the Examiner asserts that the cited portions of *Schumacher* disclose the acknowledged shortcomings in *Weinberg*. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Schumacher*.

The Applicants respectfully submit that *Schumacher* fails to disclose, teach, or suggest independent Claim 2 limitations regarding “**recording the sequence of actions of the user in a member selection script**, the member selection script **including a hierarchy selection command for determining the sequence of actions to be recorded**”. In particular, the Examiner equates “**recording the sequence of actions**” recited in independent Claim 2, with “**applet event recorder**” disclosed in *Schumacher*. (19 December 2006 Office Action, Page 4). However, the “**applet event recorder**” disclosed in *Schumacher* merely places listeners on each component of the applet, but **does not include, involve, or even relate to recording the sequence of actions**, as recited in independent Claim 2. (Column 2, Lines 12-29). For example, the “**applet event recorder**” in *Schumacher* merely emulates the user interaction sequence but fails to teach, suggest, or even hint at providing **a hierarchy selection command for determining the sequence of actions to be recorded**, as recited in independent Claim 2. (Column 6, Lines 1-10). Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Schumacher* and independent Claim 2 cannot be made. The Applicants further respectfully submit that

these distinctions alone are sufficient to patentably distinguish independent Claim 2 from *Schumacher*.

The Applicants further respectfully submit that *Schumacher* fails to disclose, teach, or suggest independent Claim 2 limitations regarding “executing the recorded member selection script, ***after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface***, based upon the members and ***hierarchical relationships of the users original inputs*** from the member selection interface”. *Schumacher* does not teach, suggest, or even hint at executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user’s original intent, based upon the members and ***hierarchical relationships of the users original inputs*** from the member selection interface.

Thus, *Schumacher* cannot provide for “executing the recorded member selection script, ***after the hierarchy of members has been modified, to reproduce the users original input to the member selection interface***, based upon the members and ***hierarchical relationships of the users original inputs*** from the member selection interface”, since *Schumacher* does not even provide for (1) recording the sequence of events (actions) that the user went through to determine the members that are selected; or (2) executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user’s original intent. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Schumacher* and independent Claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 2 from *Schumacher*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Weinberg-Schumacher* Combination

The Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Weinberg* or *Schumacher*, either individually or in combination. The Office Action has not shown the

required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the arts at the time of the applicant’s invention to modify the teachings of *Weinberg* by incorporating recording the sequence of actions of the user in a member selection script”. (19 December 2006 Office Action, Page 5). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Weinberg* or *Schumacher*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed “for the purpose of having a system that can save the user time since it can recreate the user’s interactions and provide results without requiring the user’s input each time the system is used.” (19 December 2006 Office Action, Page 5). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does “provid[ing] results without requiring the user’s input” directly “save the user time” and to what extent does the Examiner purport that “recreat[ing] the user’s interactions” applies to the subject Application.

The Applicants respectfully request the Examiner to point to the portions of Weinberg or Schumacher which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage. In particular, the Applicants respectfully request the Examiner to point to the portions of *Weinberg* or *Schumacher* which expressly states that “recreat[ing] the user’s interactions” equates to “executing the recorded member selection script, ***after the hierarchy of members has been modified, to reproduce the user’s original input to the member selection interface***, based upon the members and ***hierarchical relationships of the user’s original inputs*** from the member selection interface”, as recited in independent Claim 2. The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the **Examiner has not adequately supported the selection and combination of Weinberg or Schumacher to render obvious the Applicants claimed invention.** The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the arts at the time of the applicant's invention to modify the teachings of *Weinberg* by incorporating recording the sequence of actions of the user in a member selection script" and "for the purpose of having a system that can save the user time since it can recreate the user's interactions and provide results without requiring the user's input each time the system is used", **does not adequately address the issue of motivation to combine.** (19 December 2006 Office Action, Page 5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Weinberg or Schumacher**, either individually or in combination.

The Applicants Claims are Patentable over the Proposed Weinberg-Schumacher Combination

With respect to independent Claims 13 and 23 these claims includes limitations similar to those discussed above in connection with independent Claim 2. Thus, independent Claims 13 and 23 are considered patentably distinguishable over the proposed combination of *Weinberg* and *Schumacher*, for at least the reasons discussed above in connection with independent Claim 2.

Furthermore, with respect to dependent Claims 3-11, 14-21, and 24-31: Claims 3-11 depend from independent Claim 2; Claims 14-21 depend from independent Claim 13; and Claims 24-31 depend from independent Claim 23. As mentioned above, each of independent Claims 2, 13, and 23 are considered distinguishable over *Weinberg* and *Schumacher*. Thus, dependent Claims 3-11, 14-21, and 24-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that independent Claims 2, 13, and 23 and dependent Claims 3-11, 14-21, and 24-31 are not rendered obvious by the proposed combination of *Weinberg* and *Schumacher*. The Applicants further respectfully submit that independent Claims 2, 13, and 23 and dependent Claims 3-11, 14-21, and 24-31 are in condition for allowance. Thus, the Applicants respectfully requests that the rejection of Claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 2-11, 13-21, and 23-31 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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Date

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